

**Amendment and Response under 37 C.F.R. 1.116**

Applicant: Michael Whitmarsh et al.

Serial No.: 09/710, 287

Filed: November 10, 2000

Docket No.: 10003977-1

Title: PRINT PROCESSING SYSTEM AND METHOD WITH DOCUMENT ADVISOR SERVICE**REMARKS**

The following Remarks are made in response to the Final Office Action mailed January 6, 2005, in which claims 1-39 were rejected. With this amendment, claims 1 and 19 have been amended to clarify Applicant's invention. Claims 1-39 remain pending in the application and are presented for reconsideration and allowance.

**Claim Rejections under 35 U.S.C. § 103**

Claims 1-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sevcik et al. U.S. Patent No. 6,330,542 and in view of Nakatsuyama U.S. Patent No. 5,875,441.

With this Amendment, independent claim 1 has been amended to clarify that the method includes determining at least one document type for the print job with the print processing system controller based on characteristics of the print job as included in the data file for the print job. In addition, independent claim 19 has been amended to clarify that the print processing system controller is adapted to process the data file for the print job and analyze characteristics of the print job to determine at least one document type for the print job based on characteristics of the print job as included in the data file for the print job.

With respect to the Sevcik et al. and Nakatsuyama patents, neither of these patents, individually or in combination, teach or suggest a method of processing a print job, as claimed in independent claim 1, nor a system for processing a print job, as claimed in independent claim 19. For example, the system of the Nakatsuyama patent retrieves specific document types that can generate a document satisfying a query 3a as designed by the user, wherein the query is a condition that documents to be retrieved should satisfy and includes a designation such as an element type of an element in a document, a connection relationship between the elements, and a string that is included in a text in an element (col. 6, lines 47-59). The system of the Nakatsuyama patent, however, does not determine a document type for the print job based on characteristics of the print job itself as included in a data file for the print job.

In view of the above, Applicant submits that independent claims 1 and 19 are each patentably distinct from the Sevcik et al. and Nakatsuyama patents and, therefore, are each in a condition for allowance. Furthermore, as dependent claims 2-18 further define patentably distinct claim 1 and dependent claims 20-39 further define patentably distinct claim 19,

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Applicant submits that dependent claims 2-18 and dependent claims 20-39 are also in a condition for allowance. Applicant, therefore, respectfully requests that the rejection of claims 1-39 under 35 U.S.C. 103(a) be reconsidered and withdrawn and that claims 1-39 be allowed.

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In view of the above, Applicant respectfully submits that pending claims 1-39 are all in a condition for allowance and requests reconsideration of the application and allowance of all pending claims.

Any inquiry regarding this Amendment and Response should be directed to either Robert C. Sismilich at Telephone No. (858) 655-8329, Facsimile No. (858) 655-5859 or Scott A. Lund at Telephone No. (612) 573-2006, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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**CERTIFICATE UNDER 37 C.F.R. 1.8:** The undersigned hereby certifies that this paper or papers, as described herein, are being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) 872-9306 on this 1<sup>st</sup> day of March, 2005.

  
By \_\_\_\_\_  
Name: Scott A. Lund